REMARKS

In view of the following reasoning for allowance, the applicants hereby respectfully request further examination and reconsideration of the subject application.

A.   The 35 USC 112, First Paragraph, Rejection of Claims 1, 12 and 19.

Claims 1, 12 and 19 stand rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. It was contended that the subject matter was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it most nearly connected, to make and/or use the invention.

More specifically, the Examiner contended that FIG. 2 discloses that a payload delivery service and a payload processor are located inside a portable computing device 112 and that portable computing device 112 is in wireless communication with a global computer network 116, which is different from what is claimed in Claims 1, 12 and 19. The applicant has amended Claims 1, 12 and 19 to conform with the specification and drawings.

It is believed the amended claims now fulfill the requirements of 35 USC 112, first paragraph. Therefore, it is respectfully requested that the rejection of Claims 1, 12 and 19 be reconsidered based on the amended claim language.

B.   The 35 USC 103 Rejection of Claims 1-23.

Claims 1-23 were rejected under 35 USC 103(a) as being unpatentable over Witz, Sr. et al. (U.S. Patent No. 5,992,752), hereinafter Wilz), in view of Perkowski (U.S. Patent No. 7,089,199). The Examiner contended that Wilz teaches all of the features of the applicant's claimed invention, but does not teach an interaction system

catalog storing tag format invormation that correlates the tag identity information with an information category to obtain one or more functional payloads operable by the payload processor. The Examiner, however, further contended that Perkowski discloses this features, thereby rendering the applicant's claims obvious. The applicants respectfully traverse this contention of obviousness.

In order to deem the applicants' claimed invention unpatentable under 35 USC 103, a prima facie showing of obviousness must be made. To make a prima facie showing of obviousness, all of the claimed elements of an applicants' invention must be considered, especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

The applicant's claimed invention provides links between physical objects and the rich information, interactions, and other services that are available over computer networks. A wireless programmable user interaction system allows a user to interact with networked services relating to physical objects that have associated machine-readable tags. The machine-readable tags may be of virtually any format, including bar codes and radio frequency identifiers (RFIDs), for example. (Summary, Paragraph 5)

In one implementation, the system includes a portable interaction device in wireless communication with a local computer network. The portable interaction device includes a portable computing device such as a hand-held computer, a tablet computer, a cellular telephone, etc., and an associated machine-readable tag reader (e.g., a bar code reader). With such a portable interaction device, a user may scan the tag of a physical object (e.g., a book in a shop, a product in a grocery store, art in a gallery, etc.) and generate tag identity information relating to the physical object. (Summary, paragraph 6)

An interaction system catalog in the portable computing device stores tag format information that correlates the tag identity information with an identity information category and related information. As a result, the interaction system catalog can indicate the types of information, interactions, or other computer network services that are available and relevant to the physical object. Upon selection of a desired network service by a user, a functional payload is delivered to the portable computing device over the wireless network connection to be executed or rendered (collectively, executed). The functional payload may be executed directly by the portable computing device or, as in one implementation, by a browser running on the portable computing device. The functional payload may originate from the local network with which the wireless communication takes place or from any payload server located anywhere on the public global computer network. (Summary, paragraph 7, emphasis added)

In addition to the tag format information, user interaction system catalog 208 stores identifiers or indications of one or more payloads 216 that are available for the type of the identity information 204, and also a computer network address indicating a location for each payload 216. Optionally, user interaction system catalog 208 may also store identifiers or indications of one or more payloads 216, and associated network addresses, that are available for specific identity information 204. (paragraph 24)

In contrast, Wilz teaches an Internet-based system for enabling information-related transactions over the internet using Java-enabled internet terminals provided with bar code symbol readers for reading Java-Applet encoded bar code symbols. The transaction-enabling Java-Applet is embedded within 2-D bar code symbol. An HTML-encoded document and code associated with the transaction-enabling Java-Applet is created and stored in an HTTP server for use in enabling a predetermined information-related transaction. When a bar code symbol encoded with a transaction-enabling Java-Applet is read using a bar code symbol reader interfaced with a Java-enabled Internet terminal, the corresponding code is automatically accessed and the HTML-encoded document is displayed at the terminal, and the

transaction-enabling Java-Applet initiated for execution so that the customer, consumer or client desiring the transaction can simply and conveniently conduct the information-related transaction over the Internet. (Abstract)

Wilz, however, does not teach the applicants' claimed **interaction system catalog in the portable computing device that stores tag format information that correlates the tag identity information with an identity information category and related information.**

Perkowksi teaches a technique for managing and delivering manufacturer-specified consumer product information to consumers in the marketplace. For a plurality of UPN-labeled consumer products offered for sale within a the marketplace, the manufacturer of the plurality of UPN-labeled consumer products or an agent thereof, accesses an Internet-enabled relational database and store therein, information elements representative of (1) a plurality of universal product numbers (UPNs) assigned to the plurality of UPN-labeled consumer products manufactured by the manufacturer and registered with the relational database, and (2A) a trademark (TM) symbolically linked to each the UPN, (2B) a product description (PD) symbolically linked to each the UPN, and (2C) one or more uniform resource locators (URLs) symbolically linked to each the UPN, wherein each the URL specifies the location of an information resource located on the Internet and related to one of the plurality of UPN-labeled consumer products registered with the relational database by the manufacturer, and wherein a UPN/TM/PD/URL data link is created and maintained in the relational database for each the UPN-labeled consumer product registered with the relational database by the manufacturer. A consumer within the marketplace transmits a request to the relational database from the Internet-enabled client computer. The UPN, TM and/or PD contained in the request enabled the consumer to access the URLs symbolically linked to the UPN, TM and/or PD, and the URLS are then transmitted to the Internet-enabled client computer for display to and use by a consumer in accessing information resources stored in the Internet-based product information servers, at the URLs. (Abstract)
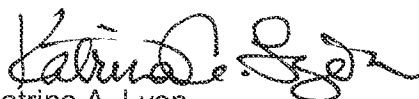
Perkowski, however, does not teach the applicants' claimed **interaction system catalog in the portable computing device** stores tag format information that correlates the tag identity information with an identity information category and related information. The Examiner contends that Perkowski teaches an interaction system catlog at FIG. 1, UPC catalog 3, col. 14, lines 53-57 but this catalog does not reside on a portable computing device (it is a separate subsystem connected to other devices by input and output connectivity subsystems 8), as is now recited in the applicant's independent claims 1, 12, and 19, as amended.

Accordingly, the Wilz in combination with the Perkowski reference do not teach the advantageous features of the applicants' claimed invention such as storing a vast amount of interaction information on the portable computing device so it is not necessary to retrieve all information from another site or device. Accordingly, no prima facie case of obviousness has been established in accordance with the holding of *In Re Fine*. This lack of prima facie showing of obviousness means that the rejected claims are patentable under 35 USC 103 over Wilz in combination with the Perkowski. As such, it is respectfully requested that Claims 1-23 be allowed based on the following amended claim language:

> " an interaction system catalog in the portable computing device storing tag format information that correlates the tag identity information with an identity information category to obtain one or more functional payloads operable by the payload processor...."

In summary, it is believed that the claims 1-23, as amended, are in condition for allowance. Allowance of these claims at an early date is courteously solicited.

Respectfully submitted,

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